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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/014,341	01/27/98	INVIE	J 53929USA3A

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STEPHEN W. BUCKINGHAM  
3M OFFICE OF INTELLECTUAL  
PROPERTY COUNSEL  
PO BOX 33427  
ST PAUL MN 55133-3427

EXAMINER

NAKARANI, D

ART UNIT

PAPER NUMBER

1773

14

DATE MAILED: 12/08/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/014,341

Applicant(s)  
Invie et al

Examiner  
D. S. Nakarani

Group Art Unit  
1773



☒ Responsive to communication(s) filed on Jul 14, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-29 and 31-44 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-8, 10-22, 25-29, 31, and 35-42 is/are allowed.

☒ Claim(s) 9, 23, 24, 32-34, 43, and 44 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 32-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support for R<sup>1</sup> as being substituted with both nitrogen and hetroatoms, functional groups or halogens. The specification as originally filed provides support for R<sup>1</sup> group containing one or more heteroatoms (e.g. oxygen, nitrogen, or sulfur) as functional groups (e.g. carbonyl, amino, or sulfonamide). (Page 13, lines 4-8). The Examiner is unable to find support for R<sup>1</sup> group having both substituents nitrogen and heteroatoms, functional groups or halogens. Applicants have failed to point where support can be found for the claimed R<sup>1</sup> group
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 9, 23, 24, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9, depends form claim 8 which defines R<sub>f</sub> as being a perfluoropolyether group.

Claim 9, lines 3-4, the perfluoropolyether group having repeating units of - (C<sub>n</sub>F<sub>2n</sub>)- or -(CF(Z))-

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can not be understood since the polymer group having these repeating units does not result in a perfluoropolyether group.

Claim 23, line 1, the phrase "the step of gravure coating" lacks clear antecedent basis. No step of gravure coating has been previously recited therefore limitation cannot be understood.

Claims 1 and 43 and claims 15 and 44 are appears to be duplicate claims. No difference between claims 1 and 43 other than the phrase "a coating composition comprising" in claim 1 line 3, is seen. The coating composition of claim 1 recite at least one fluorinated silane which is the same as in claim 43 and there is no other component recited for the coating composition. The claim language of both claims 1 and 43 is an open language and inclusive of other components.

Likewise claims 15 and 44 are appears to be duplicate claim since the difference between claim 15 and claim 44 is the phrase "coating composition comprising".

5. Claims 1-8, 10-22, 25-29, 31 and 35-42 are allowed.

6. The amended claims overcomes the rejection under 35 U.S.C. & 102(b) as being anticipated by Ochiai et al. (EP 0749021 A2). Also the amended claims are not obvious over Ochiai et al. since Ochiai et al. fail to teach or suggest claimed R<sup>1</sup> group.

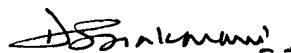
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (703) 308-2413. The examiner can normally be reached on Tuesday - Friday from 7:00 a.m. to 5:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul J. Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

D.S. Nakarani/om  
December 4, 2000

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**